

Appl. No. 09/272,240
Amdt. dated September 8, 2004
Reply to Office Action of May 19, 2004

PATENT
Docket: 990382

REMARKS

Claims 1-26 are pending in the application. Applicant has amended Claims 7, 11, 14, and 20. Applicant requests reconsideration and allowance of all pending claims.

Discussion of Rejections Under 35 U.S.C. §112

Claim 7 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for allegedly including "subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the invention was filed, had possession of the claimed invention." In particular, the examiner points to the feature "the sequence of inputs uses an overridden key on said keypad."

Original claim 7, as filed, included the feature identified by the examiner, and the original claims form part of the specification. There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257 (CCPA 1976). "[I]psis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question." *Fujikawa v. Wattanasin*, 93 F.3d 1559 (Fed. Cir. 1996).

Applicant respectfully contends that the detailed description includes a clear description of the claimed feature. However, in an effort to facilitate allowance of the claim, Applicant amends claim 7 to replace the term "overridden" with the term "overloaded" such that the claim repeats verbatim the term used in the detailed description. Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §112 in light of the amendment.

Discussion of Rejections Under 35 U.S.C. §102

Claims 1-2, 6, 8-12, 14-15, 17, and 21-23 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,122,530 to Overy, et al. (hereinafter Overy). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of*

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California, 814 F.2d 628 (Fed. Cir. 1987). The examiner contends that all of the elements of the claims are set forth in Overy.

Claim 1 recites a "method of programming a macro to selectively operate features of a personal wireless communication handset" comprising "defining a procedure for retrieving the sequence of inputs from the memory." This feature is not set forth, either expressly or inherently described, in Overy.

Overy discusses a telephone that includes soft keys that can correspond to phone numbers entered by a user. Overy Col. 4 ll. 40-45. In Overy, the soft keys operate a speed dialing keys when in the EASY OPERATION mode. The user can input phone numbers that are assigned to the smart keys (Overy Col. 6 ll. 3-8). However, the user cannot "define a procedure for retrieving the sequence of inputs" as featured in claim 1. Instead, the telephone described in Overy only allows the soft key to correspond to the speed dial number and does not allow for defining a procedure for retrieving the sequence of inputs.

Thus, at most, Overy discloses a telephone that allows a user to enter a value in predetermined fields associated with predetermined keys when the phone is operated in a specific mode. This is contrary to the feature of claim 1 that allows for "defin[ing] a procedure for retrieving the sequence of inputs." Therefore, Applicant respectfully requests reconsideration and allowance of claim 1 because Overy fails to set forth every element of the claim.

Claims 11, 14, 17, 21, 22, include a feature similar to that discussed above in relation to claim 1 and are believed to be allowable over Overy for the same reasons as provided above for claim 1. Applicant respectfully requests reconsideration and allowance of claims 11, 14, 17, 21, 22.

Discussion of Dependent Claims

Claims 2, 6, 8-10, 12, 15, and 23 depend from one of claims 1, 11, 14, 17, 21, and 22, and are believed to be allowable at least for the reason that they depend from an allowable base claim. Applicant respectfully requests reconsideration and allowance of claims 2, 6, 8-10, 12, 15, and 23.

Discussion of Rejections Under 35 U.S.C. §103(a)

Claims 3, 5, 13, 16, 18, 20, 24, and 26 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Overy in view of U.S. Patent No. 6,360,110 to Schmidt. Claims 4 and 25 were

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rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Overy in view of U.S. Patent No. 6,002,946 to Reber, et al. (hereinafter Reber). Additionally, claim 7 was rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Overy in view of U.S. Patent No. 6,185,295 to Frederiksen et al. (hereinafter Frederiksen).

In order to establish a prima facie case of obviousness, the prior art references must teach or suggest all claim limitations. There must be some suggestion or motivation to modify the reference or combine the reference teachings. Also, there must be a reasonable expectation of success in the combination or modification. Applicant respectfully contends the references, either alone or in combination, fail to teach or suggest all claim limitations, and there is no motivation to modify the references in a manner that provides for the missing claimed features.

Discussion of Rejections based on Overy in view of Schmidt

As discussed above in the portion discussing rejections under 35 U.S.C. §102, Overy fails to set forth every feature of claims 1, 11, 14, 17, 21, and 22. Similarly, Schmidt fails to disclose the features of the independent claims that are not set forth in Overy. Schmidt fails to disclose "defining a procedure for retrieving the sequence of inputs from the memory." Instead, Schmidt, discloses a phone in which a call address can be assigned to a push-to-talk (PTT) key. Thus, like Overy, Schmidt merely discusses how a user can enter a value in a field that is assigned to a predetermined key in a predetermined operating mode of the phone.

Claim 20 similarly includes the feature of a controller "having a programming mode in which a user may enter a set of keypad inputs using the user interface for storage and define a procedure for retrieving the set of keypad inputs from storage to operate at least one selected feature of the handset." Thus, for the same reasons provided for claim 1, Applicant contends that the cited references fail to disclose all features of claim 20.

Claims 3, 5, 13, 16, 18, 24, and 26 depend, either directly or indirectly, from one of claims 1, 11, 14, 17, 21, and 22. Applicant thus contends that dependent claims 3, 5, 13, 16, 18, 24, and 26 are allowable at least for the reason that Overy and Schmidt, either alone or in combination, fail to disclose every feature of independent claims 1, 11, 14, 17, 21, and 22.

Discussion of Rejections based on Overy in view of Reber

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Claims 4 and 25 depend from one of claims 1 and 22. As discussed above in the portion discussing rejections under 35 U.S.C. §102, Overy fails to set forth every feature of claims 1 and 22. Similarly, Reber fails to disclose the features of the independent claims that are not set forth in Overy. Reber discusses an optical data reader for a handheld device and thus does not mention or suggest "defin[ing] a procedure for retrieving the sequence of inputs." Therefore, Overy and Reber, either alone or in combination, fail to disclose every feature of independent claims 1 and 22. Applicant contends that claims 4 and 25 are allowable over Overy in view of Reber at least for the reason that they depend from an allowable base claim.

Discussion of Rejections based on Overy in view of Frederiksen

Claim 7 depends from claim 1 and is believed to be allowable over Overy in view of Frederiksen at least for the reason that it depends from an allowable base claim. Frederiksen discusses a phone number database for speed dialing and, like Overy, discusses a dedicated key that can be used for speed dialing purposes, depending on the mode of the phone. Frederiksen Col. 3 ll. 19-22. Thus, Frederiksen, like Overy, fails to disclose "defin[ing] a procedure for retrieving the sequence of inputs." Applicant thus contends that claim 7 is allowable over Overy in view of Frederiksen at least for the reason that it depends from an allowable base claim. Applicant respectfully requests reconsideration and allowance of claims 3-5, 7, 13, 16, 18, 20, and 24-26.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-845-8450.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated

9/8/04

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